



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,199	11/16/1999	TAKANARI YAMAGUCHI	2185-0380P	3990

7590

07/31/2002

BIRCH STEWART KOLASCH & BIRCH LLP
P O BOX 747
FALLS CHURCH, VA 220400747

EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 07/31/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/441,199

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 June 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-5.Claim(s) withdrawn from consideration: 6-9.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Jeffrey C. Mullis
J Mullis
Art Unit: 1711

Art Unit 1711

With regard to the objection under 35 U.S.C. § 1.75(c), applicants argue that the resin may be present before the introduction of the rubber into the extruder or the resin may be introduced after the introduction of the rubber. However instant claim 1 recites that the rubber is turned into a molten rubber and is fed into an extruder and in the last two lines of claim 1 recites that "the molten rubber is melt kneaded with the thermoplastic resin in the extruder". Since the rubber is fed into the extruder where it is mixed with a thermoplastic resin and since the thermoplastic is only mixed with the molten rubber, it is not clear how the resin could be introduced at any point except after the rubber becomes molten.

The issue regarding "a rubber's viscosity" under 35 U.S.C. § 112 second paragraph is hereby withdrawn.

With regard to the issue of diameter in claim 2, the Examiner has reviewed applicants' copy of JIS K7199. However the Examiner can see nothing that indicates that the diameter would affect viscosity. The Examiner is aware that viscosities are strongly dependent upon temperature and with respect to temperature, shear and retentive times, it is not clear what these have to do with the effect of the diameter.

With regard to the rejection under 35 U.S.C. § 112 second paragraph and the term "block-like", this issue is hereby withdrawn.

Art Unit 1711

With regard to the rejection under 35 U.S.C. § 102, applicants argue that Guntherberg '399 does not teach, disclose or suggest the feeding of a molten rubber into an extruder. However, the materials of Guntherberg et al. are all processed in an extruder. Note lines 7-8 of the Abstract in this regard. Therefore a molten rubber is introduced into an extruder in Guntherberg. Applicants make other allegations regarding the teachings of Guntherberg through the last complete sentence of their remarks at the bottom of page 5. The Examiner does not necessarily disagree with these allegations. However it is not clear what they have to do with patent limitations present in the claims. Applicants make similar arguments regarding the rejection under 35 U.S.C. § 103 relying upon Guntherberg. However the Examiner's position is the same as set out above in response to applicants' arguments under 35 U.S.C. § 102 regarding Guntherberg.

With regard to the disclosure of Furuta '765, applicants argue that Furuta '765 does not teach, disclose or suggest the feeding of a molten rubber into an extruder. However, Furuta has not been relied upon for such a teaching.

With regard to applicants' arguments on page 8 pertaining to Guntherberg in view of Furuta, it is the position of the Examiner that the only elements of the claims not taught by the primary reference Guntherberg is the specific species elected by

Art Unit 1711

applicants such as the independent claim is not limited to. The only other element not taught is the block copolymer of claim 4 which is not required by applicants' other claims. With regard to the use of applicants' block copolymer, the motivation to use such in the primary reference is the benefits taught by the secondary reference. Therefore requirements "1" and "3" discussed on page 8 of applicants' remarks are met by the combination of references. With regard to a reasonable expectation of success, it does not appear that anything more would be necessary to arrive at applicants' process successfully would be to substitute one material for another.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

July 28, 2002

Jeffrey Mullis
Primary Examiner
Art Unit 1711

